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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant: Amit V. Patel
Application No.: 10/706,638
Filing Date: November 12, 2003
Art Unit: 3772
Examiner: Brandon Jackson

Title: Injury Immobilization Device

REQUEST FOR RECONSIDERATION AND WITHDRAWAL OR MODIFICATION OF
RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This document is a response to the Office Communication dated February 12, 2007. I am making a request for reconsideration and withdrawal or modification of the restriction requirement that was originally sent to me in the October 31, 2006 Office Action.

I responded to the October 31, 2006 Office Action on January 26, 2007. In my January 26, 2007 response, I elected to prosecute Species II, or claims 13-23, of my patent application. In the February 12, 2007 Office Action, the Examiner said "Applicant may not cancel elected claims and then submit withdrawn claims to be examined. The policy of the office is not to permit the applicant to shift to claiming another invention after an election is made and an action on the merits of the elected subject matter is made." Notwithstanding the Examiner's statement, the Patent Office Rules (1.143) say that if an applicant disagrees with the

requirement for restriction and makes a request for reconsideration, the "requirement for restriction will be reconsidered on such a request." All I really want is to proceed on the merits of this case, and if that means I have to choose one Species, then I want to proceed with the Species II claims and withdraw the Species I claims.

On October 25, 2006, before sending me any Office Action, the Examiner telephoned me to tell me he was making a requirement for restriction and told me I had to choose one of two Species of the invention I had claimed in my patent application. The Examiner recommended that I choose Species I. As I pointed out in my Response dated January 26, 2007, during the telephone call with the Examiner "I had not seen the office action and did not fully appreciate the difference between the two Species in relation to the objections the Examiner had with them," and I did not fully understand what was meant by the restriction requirement. All I had was the Examiner's recommendation to go on.

After the telephone call, I received the written Office Action, which asked me to affirm the selection of Species I. Once I read the Restriction Requirement in the Office Action, I understood a little bit better what the examiner was talking about. Nevertheless, the Office Action specifically said "Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits." (Page 2 of the Office Action). The Office Action also said "Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement."

My July 26, 2007 response was a good faith effort to respond to these requirements, and I elected a single disclosed species, described by the examiner as "II. Figure 4 directed at claims 13-23." I also replied in great detail to the entire Office Action, and my reply "included an identification of the species [i.e., II] that is elected consonant with this requirement." Based on the requirements sent to me in the Office Action, I believed that I was responding in a way that advanced the merits of this case. I further clarified in my response that "I am not affirming the election of Species I but instead am electing to prosecute the invention of Species II, claims 13-23."

The Examiner's recommendation that I elect the Species I claims should not be a final determination as to which claims are to be "elected" unless I "affirm" the recommendation, and I explicitly did *not* affirm the election as I showed in the language quoted above. Therefore, this communication is a request for "reconsideration and withdrawal or modification of the requirement" per the Patent Office Rule 1.143 or any other rule that may apply to this situation.

First, I request reconsideration of the restriction requirement itself. I filed one patent application for one invention, and all of its claims have to do with an "apparatus for immobilizing an injured joint of a body." There are different claims but they all go to one invention. I do not believe that examining all of the claims will be burdensome for the Examiner. I traverse the restriction requirement.

Second, I request withdrawal or modification of the requirement. In no way did I make a "provisional election ... without traverse" as alleged in Page 3 of the October 30, 2006 Office Action. All I did during the telephone call was to try to work with the Examiner based on his recommendation. At the time, I didn't even understand what a requirement for restriction was. Now I feel as if his recommendation is being used against me to bar me from proceeding with the merits of this case.

In the alternative, I request modification of the requirement by requesting reconsideration of the Examiner's demand that I drop the Species II claims in favor of the Species I claims. I never affirmed any "election without traverse" for the Species I claims and I explicitly, in writing, stated that "Claims 13-23 [the Species II claims] should not be withdrawn from consideration, and, if considered withdrawn at this time, I request that they be reinstated." I am simply trying to have my patent application examined.

I am not a patent expert: I'm an inventor. What I do know is that I've never seen any products in the marketplace that offer what my invention offers. I spent years in my town's ambulance corps while I was in high school, and my experience there helped me to realize that there was a need for an inventive device that an EMT could use to immobilize a joint on a person who has been injured and needs to be transported to a hospital or has to await further

care and treatment. I thought the device should be lightweight and portable: not all EMTs or emergency care workers are strong, and speed is of the essence in responding to an emergency, so the device had to be easy to carry and use. I also thought the device had to be adjustable to fit different sized people/patients, and preferably it had to have some flexibility so it could fit contours of the body. It also had to be adjustable to fit the different angles at which an injured body part might need to be immobilized. What I invented solved all of these problems, unlike any other device I've ever seen.

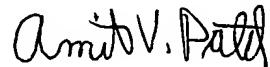
I am now a third-year cadet at the United States Military Academy, trying to serve my country. I am majoring in mechanical engineering and believe in the merits of this invention and patent application. I am trying my best to prosecute this application on its merits, and I just ask for the opportunity to do so.

If this request for reconsideration is not accepted, I will file a Petition to the Director of the Patent Office.

I also ask that the amendments I submitted in my January 26, 2007 response be accepted and entered. The present request and my January 26, 2007 response show my good faith efforts to advance this application to allowance.

In view of the above and in view of my January 26, 2007 response, I believe that the present application, including claims 13- 17 and 19-23, is in condition for allowance. Favorable reconsideration is therefore respectfully requested.

Respectfully submitted,



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Date: Friday, March 9, 2007